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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/974,862	10/12/2001	Kazuhiko Kajiwara	2091-0248P	7456
2292	7590	09/12/2005	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			RUHL, DENNIS WILLIAM	
			ART UNIT	PAPER NUMBER

3629

DATE MAILED: 09/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/974,862

Applicant(s)

KAJIWARA, KAZUHIKO

Examiner

Dennis Ruhl

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Handwritten mark resembling a stylized 'A' or 'H'.

Applicant's response of 6/14/05 has been entered. Currently claims 1-8 are pending. The examiner will address applicant's remarks at the end of this office action.

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claims 1,4,8, it is not clear what the language "*in relation to user information specific to the user and usable only at the store*" is intending to recite. What does the "usable only at the store" portion recite in the way of structure or a step? What is usable only at the store, the image data or the user information that is specific to the user? This portion of the claim is indefinite.

For claim 7, the portion of the claim that reads, "*preparing another DP bag in which printed the DP number obtained from the order number indicated in the receipt*" is indefinite. To start with, this language reads poorly. What has the DP number printed on itself? It has not been claimed that the receipt has a DP number. All that is claimed is that the receipt has an order number and the DP bag as a DP number. What DP number from the receipt is being referred to here, as none seems to have been claimed? The examiner is not clear as to what the number is that is being claimed here and where the number is claimed as being.

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3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4-6,8, are rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund et al. (5666215).

For claims 4,8, Fredlund discloses a system (printing terminal) that allows a user to obtain prints of their photos. The processing lab 14 receives film from customers and uses a *means for obtaining image data* 16 to process the image data and then uses a *database 28 to store the image data* for later retrieval. The *printer* is any one of 106, 108, or 110. Fredlund discloses an *order terminal* in the form of a computer 42. The order terminal is connected to the printing terminal by a network 40. The limitation of "a local network" has been considered to be just a network, because the word *local* adds no further structure to the limitation of a network. With respect to the recitations directed to how the system works, the system of Fredlund is fully capable of operating as claimed and does disclose the same claimed steps, with the exception of the order number/receipt. Because the recitation of outputting an order number (and a receipt) recites no further structure to the system, and because the system of Fredlund is fully capable of performing the recited intended use (output of order number, receipt), Fredlund satisfies what is claimed. Applicant is reminded that intended use recitations must result in a structural difference between the prior art to define over the prior art.

The prior art is properly applied as long as the prior art is fully capable of performing the claimed intended use. This is the case with Fredlund.

Additionally, just about all of the intended use recitations are disclosed by Fredlund. See column 3, lines 22-26 for the disclosure of *obtaining image data from film*. See column 3, lines 28-36 for the limitation of *storing the image data in the database*. The claimed step of *receiving an order for a print of image data* is done in Fredlund when a user activates the "place order command button 64" and finishes their placement of an order. Image data is then read from the database 28 and printed as claimed. The limitation of inputting user information is inherent to the process of Fredlund. This is because Fredlund discloses "*Responding to the instructions 29 and using appropriate identification, the customer through....is able to access the low resolution version of their digital image file, contained in storage device 28*". The customer must inherently input some information to be able to access the images and must somehow input some kind of data that identifies who they are.

Not disclosed by Fredlund is that the order terminal 42 is "in the store". The examiner takes notice of the Background of the Invention section of Fredlund, where it is disclosed that Kodak TM has a system for the processing of prints where "*the customer goes to a photo store or mini lab location, inserts his negatives and zooms and crops or enlarges the image prior to printing*". The idea of having a photo processing terminal located in a photo store (mini lab, processing lab, etc.) that customers can use to customize their photos old and is well known in the art. Fredlund is directed to a remote ordering terminal, but the idea of having a non-remote terminal

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(i.e. in the store) is disclosed by Fredlund. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have an ordering terminal located in the store, so that a customer in the store can have access to the printing system of Fredlund and all of the options it provides to customize your photos and their printing. This way a customer without a computer at home can take advantage of the options and features that the system of Fredlund provide as far as photo printing goes. Applicant's claimed system and the system of Fredlund are essentially the same, with the exception that applicant is claiming the order terminal as being in the store as opposed to an undefined remote location. Fredlund discloses the same ordering terminal connected by a network to the printing terminal, just as applicant has. Applicant is just claiming the location/placement of the order terminal as being in the store which is considered obvious to one of ordinary skill in the art. One of ordinary skill in the art would recognize and find it obvious that one could vary the many locations that an order terminal could be placed. A photo processing lab or store would be the most obvious location and in view of the fact that the prior art already has customer photo printing terminals in photo stores, the claimed limitation would have been obvious to one of ordinary skill in the art.

For claims 5 and 6, they are reciting what the user information is, that is inputted by the user, and this is directed to the intended use of the system. These claims are not reciting any further structure to the system and are satisfied by Fredlund. The number is not part of the system but is part of the intended use of the system and the way the claim is written no further structure is being claimed. Fredlund satisfies what is claimed.

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With respect to claim 8, in addition to that already addressed, the examiner wants to inform applicant that the language “by reading images *from a film in a DP bag*” in relation to the recited “means for obtaining image data” has been considered but is satisfied by the processor 16 of Fredlund. This means language is defining or reciting a structural element that reads the image data. Whether or not the film was inside a bag does not matter, and defines no further structure. This portion is claiming a means to read the image data, with the film bag part defining no further structure to the system. The bag is not being claimed in a positive sense, but only with respect to the means to read the image data. A bag with a DP number is not being positively claimed.

5. Claims 1-3,7, are rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund et al. (5666215) in view of Enomoto et al. (5974401).

For claims 1,7, Fredlund discloses a method and system that allows a user to obtain prints of their photos. A user can bring their film to the lab 14, and at this time they are requesting development and printing of the film. The processing lab 14 receives film from customers and uses a *means for obtaining image data* 16 to process the image data and then uses a *database 28 to store the image data* for later retrieval. The *printer* is any one of 106, 108, or 110. Fredlund discloses an *order terminal* in the form of a computer 42. The order terminal is connected to the printing terminal by a network 40. The limitation of “a local network” has been considered to be just a network, because the word *local* adds no further structure to the limitation of a network. See column 3, lines 22-26 for the disclosure of *obtaining image data from film*. See

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column 3, lines 28-36 for the limitation of *storing the image data in the database*. The claimed step of *receiving an order for a print of image data* is done in Fredlund when a user activates the "place order command button 64" and finishes their placement of an order. Image data is then read from the database 28 and printed as claimed. The limitation of inputting user information is inherent to the process of Fredlund. This is because Fredlund discloses "*Responding to the instructions 29 and using appropriate identification, the customer through....is able to access the low resolution version of their digital image file, contained in storage device 28*". The customer must inherently input some information to be able to access the images and must somehow input some kind of data that identifies who they are.

Not disclosed by Fredlund is that the order terminal 42 is "in the store" and that an order number is outputted corresponding to the order.

With respect to having the order terminal in the store, the examiner takes notice of the Background of the Invention section of Fredlund, where it is disclosed that Kodak™ has a system for the processing of prints where "*the customer goes to a photo store or mini lab location, inserts his negatives and zooms and crops or enlarges the image prior to printing*". The idea of having a photo processing terminal located in a photo store (mini lab, processing lab, etc.) that customers can use to customize their photos old and is well known in the art. Fredlund is directed to a remote ordering terminal, but the idea of having a non-remote terminal (i.e. in the store) is disclosed by Fredlund. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have an ordering terminal located in the store, so that a customer in the store

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can have access to the printing system of Fredlund and all of the options it provides to customize your photos and their printing. This way a customer without a computer at home can take advantage of the options and features that the system of Fredlund provide as far as photo printing goes. Applicant's claimed system and the system of Fredlund are essentially the same, with the exception that applicant is claiming the order terminal as being in the store as opposed to an undefined remote location.

Fredlund discloses the same ordering terminal connected by a network to the printing terminal, just as applicant has. Applicant is just claiming the location/placement of the order terminal as being in the store which is considered obvious to one of ordinary skill in the art. One of ordinary skill in the art would recognize and find it obvious that one could vary the many locations that an order terminal could be placed. A photo processing lab or store would be the most obvious location and in view of the fact that the prior art already has customer photo printing terminals in photo stores, the claimed limitation would have been obvious to one of ordinary skill in the art.

With respect to the claimed outputting of an order number (on a receipt), Fredlund does not expressly disclose the existence of an order number on a receipt (paper or electronic). Enomoto discloses a photo print system where a customer is given an order number so that the order can be identified. Receipts are very well known in the art and any transaction such as photo processing involves receipts. The use of order numbers for photo processing requests is very old and well known in the art as a way to differentiate between different orders. Order numbers and receipts are nothing new. It would have been obvious to one of ordinary skill in the art at the time the

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invention was made to output a receipt and an order number as disclosed by Enomoto so that the customer and the photo processor/system have a way to identify different orders from each other and so that the customer has a proof of their transaction and can claim their photos.

For claims 2,3, applicant is claiming that the user information is a number printed on a bag (or an ID number on a card), where claim 1 recites that the user information is inputted by the user. Claims 2 and 3 have a scope that is claiming a number (or user ID) for the user information, nothing more. The part of the claim that recites the number as being printed on the bag (or stored on a card) is noted, but the bag and/or the card are not being used in any manner and are not even positively claimed in the opinion of the examiner. The inputting of the user information limitation from claim 1 is so broad that it can be by manual keyboard entry, so the bag and/or card are not even being used in the inputting step. The number or user ID that is entered by the user may be printed on the bag or stored in a card but the bag does not appear to be claimed as part of the scope of the invention and the card does not appear to be claimed as part of the scope of the invention. Nothing that is claimed requires the use of the bag or the card. Fredlund does not disclose that a number (user ID) is entered for user information. Enomoto discloses that each customer is given an ID number, and when they place an order this number identifies the customer. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the user input a customer/user ID number as disclosed by Enomoto so that the customer can be easily identified.

For claim 7, in addition to that already addressed, not disclosed by Fredlund is "obtaining image data by reading images *from a film in a DP bag*" and not disclosed is "*preparing another DP bag*". Also not specifically disclosed is the presentation of a receipt when picking up prints.

With respect to the obtaining of images from film in a bag, Fredlund does not disclose that the film is inside a bag at the time of requesting processing. It is old and well known in the photo developing industry that when a customer is dropping off film at a processing lab, bags are provided for the customer to place the film into. The use of film bags when dropping off film is unquestionably old and well known. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make film bags available to customers to put their film into when they are dropping off their film for processing, as is old and well known in the art.

With respect to the preparing of a new DP bag, this is not disclosed in Fredlund. It would have been obvious to one of ordinary skill in the art at the time the invention was made to put the printed photos in another film bag to keep the photos together. The placing of the printed photos in another film bag would have been obvious to one of ordinary skill in the art.

With respect to the presenting of a receipt in exchange for the photos, this is obvious to one of ordinary skill in the art. The providing of a receipt has already been addressed and presenting the receipt to claim your photos is obvious to one of ordinary skill in the art so that another person cannot take your photos.

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6. Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection.

Additionally, with respect to the comments that the examiner apparently is ignoring any text that follows "wherein" in the claims, the examiner never stated such and this is not the case. The examiner has clearly stated his position on this claim language and how the claims have been interpreted. This is not ignoring the language as alleged. Applicant's assumption is incorrect and applicant should understand that all language of the claims has been considered. Whether or not certain language defines anything structurally or step wise in the claims is another matter all together, but all language has been considered.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DENNIS RUHL
PRIMARY EXAMINER